



AF/3626#

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

APPELLANT: Wyatt EXAMINER: Pass #11 / Brief
SERIAL NO.: 09/544,509 GROUP ART UNIT: 3626
FILING DATE: April 6, 2000 ATTY. DOCKET NO.: MCO-P-00-003
INVENTION: "A METHOD AND SYSTEM FOR MATCHING MEDICAL
CONDITION INFORMATION WITH A MEDICAL RESOURCE ON
A COMPUTER NETWORK" 10-31-03

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S APPEAL BRIEF TRANSMITTAL LETTER

MADAM:

Appellant submits herewith, in triplicate, Appellant's Appeal Brief in support of the Notice of Appeal filed September 15, 2003. Appellant encloses a check for \$165.00 for submission of this Appeal Brief. Appellant authorizes the Patent Office to charge any fees that may be due and owing or to credit any overpayment to Deposit Account No. 50-0595. A duplicate copy of this sheet is enclosed for this purpose.

RECEIVED

OCT 30 2003

GROUP 3600

Respectfully submitted,

(Reg. No. 35,018)

Brian M. Mattson
Patents+TMS
A Professional Corporation
1914 North Milwaukee Avenue
Chicago, IL 60647
Tel: 773/772-6009



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

RECEIVED
OCT 30 2003
GROUP 3600

APPELLANT: Wyatt EXAMINER: Pass
SERIAL NO.: 09/544,509 GROUP ART UNIT: 3626
FILING DATE: April 6, 2000 ATTY. DOCKET NO.:MCO-P-00-003
INVENTION: "A METHOD AND SYSTEM FOR MATCHING MEDICAL
CONDITION INFORMATION WITH A MEDICAL RESOURCE ON
A COMPUTER NETWORK"

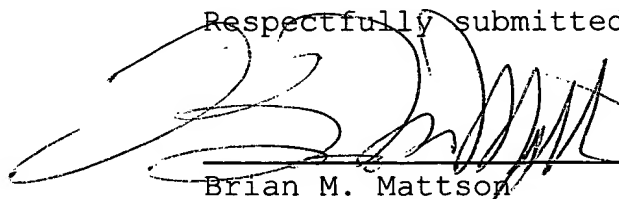
Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S APPEAL BRIEF TRANSMITTAL LETTER

MADAM:

Appellant submits herewith, in triplicate, Appellant's Appeal Brief in support of the Notice of Appeal filed September 15, 2003. Appellant encloses a check for \$165.00 for submission of this Appeal Brief. Appellant authorizes the Patent Office to charge any fees that may be due and owing or to credit any overpayment to Deposit Account No. 50-0595. A duplicate copy of this sheet is enclosed for this purpose.

Respectfully submitted,


(Reg. No. 35,018)

Brian M. Mattson
Patents+TMS
A Professional Corporation
1914 North Milwaukee Avenue
Chicago, IL 60647
Tel: 773/772-6009



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

RECEIVED
OCT 30 2003
GROUP 3600

APPELLANT: Wyatt

EXAMINER: Pass

SERIAL NO.: 09/544,509

GROUP ART UNIT: 3628

FILING DATE: April 6, 2000

ATTY. DOCKET NO.: MCO-P-00-003

INVENTION: "A METHOD AND SYSTEM FOR MATCHING MEDICAL CONDITION
INFORMATION WITH A MEDICAL RESOURCE ON A COMPUTER
NETWORK"

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S APPEAL BRIEF

MADAM:

This Appeal Brief is submitted in support of the Notice of Appeal filed on September 15, 2003. The Appeal was taken from the Final Rejection dated April 10, 2003.

I. REAL PARTY IN INTEREST

Medical Central Online is the real party in interest as the assignee of this application.

II. RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known to Appellant or Appellant's legal representative which will directly affect, be directly affected by, or have a bearing on the Board's decision in this appeal.

10/29/2003 AWONDAF1 00000009 09544509

01 FC:2402

165.00 OP

III. STATUS OF CLAIMS

Claims 1-20 are pending in this patent application. A copy of the claims is appended hereto as the Appendix. Claims 1-20 were finally rejected by the Examiner in a Final Rejection dated April 10, 2003 and are hereby on appeal. The Final Rejection is appended hereto as Exhibit A of the Supplemental Appendix.

IV. STATUS OF AMENDMENTS

All amendments have been entered in this patent application. No amendments to the claims were made after the Final Rejection.

V. SUMMARY OF INVENTION

The present invention relates to a method and a system for matching medical condition information with a medical resource. Additionally, the present invention relates to a method and a system for matching medical condition information such as, for example, diseases, disorders and/or medical procedures related thereto, with a medical resource, such as, for example, specialists, specialty hospitals, and/or any other medical resource. Further, the present invention relates to a method and a system for matching medical condition information with a medical resource contained on a computer network. (Page 7, lines 17-28.)

A system 1 may include a plurality of remote servers 10,12. Contained on the remote servers 10,12 may be websites 14,16,

respectively. Each of the websites 14,16 may be connected with databases 18,20, respectively, that may contain information related to a plurality of medical conditions and medical resources that may treat the medical conditions. The databases 18,20 may be connected so that the remote servers 10,12 may access either of the databases 18,20 at any time. The remote servers 10,12 may be incorporated within a computer network 22. (Page 7, lines 30-33 and page 8, lines 1-7)

The remote servers 10,12 may be connected via the computer network 22. The computer network 22 may be a global computer network, such as, for example, the internet or may be an intranet such as, for example, a LAN network that may be contained within a business or other entity. Remote computers 24,26 may be connected with the computer network 22 allowing an individual to access the remote servers 10,12 thereby accessing one of the websites 14,16. Of course, any number of remote computers may be used to access the websites 14,16. (Page 8, lines 18-28)

A method 50 for accessing a website and retrieving information from one of the databases 18,20 may include an access website step 52. An individual using one of the remote computers 24,26 or any other remote computer connected with the computer network 22 may access one of the websites 14,16 or any

other website that may provide access to databases 18,20 or any other database containing the information therein. (Page 9, lines 4-12)

The individual may enter personal information via a step 54, such as, for example, name, location, and/or contact information. (Page 9, lines 13-17) The individual may choose or otherwise enter a particular medical condition via a step 56 or may choose or otherwise enter a particular medical procedure via a step 58. The medical conditions may be stored within the databases 18,20, or any other database, and may include information relating to diseases 60 and/or disorders 62. (Page 9, lines 23-31) The particular medical conditions may be stored within the databases 18,20, or any other database, and may include information on the diseases 60 and/or the disorders 62. (Page 10, lines 18-21)

After an individual has chosen a particular medical condition or a medical procedure via steps 56 or 58, respectively, the individual may search the database 18,20 via a step 66. The database 18,20 may contain information related to medical resources, such as, for example, medical specialists, specialty hospitals or any other medical or health facility that may treat designated diseases 60 or disorders 62 or otherwise perform specific medical procedures. (Page 11, lines 17-25)

The medical resources may be output via step 68 in a plurality of different ways. For example, the medical resources may be matched with the medical conditions and/or medical procedures and may be designated as first level or second level as illustrated in steps 70 and 72, respectively. (Page 11, line 33 and page 12, lines 1-5) Further, the output of medical resources may provide contact information whereby an individual may contact the medical resources via the step 73. (Page 12, lines 23-25) After the medical resources have been output via the step 68, the individual may terminate his or her session with the website 14,16 or any other website via an end step 74. (Page 12, lines 28-31)

VI. ISSUES

1. Would Claims 1-11 and 13-20 have been obvious under 35 U.S.C. §103(a) to one having ordinary skill in the art at the time of Appellant's invention over *Iliff* (U.S. Patent No. 6,022,315) in view of *Schlueter, Jr. et al.* (U.S. Patent No. 5,974,124)? See *Iliff* (U.S. Patent No. 6,022,315) attached as Exhibit B of the Supplemental Appendix and *Schlueter, Jr. et al.* (U.S. Patent No. 5,974,124) attached as Exhibit C of the Supplemental Appendix.

2. Would Claim 12 have been obvious under 35 U.S.C. §103(a) to one having ordinary skill in the art at the time of Appellant's

invention over *Iliff* (U.S. Patent No. 6,022,315) in view of *Schlueter, Jr. et al.* (U.S. Patent No. 5,974,124) and further in view of *Siegrist, Jr. et al.* (U.S. Patent No. 5,652,842)? See *Siegrist, Jr. et al.* (U.S. Patent No. 5,652,842) attached as Exhibit D of the Supplemental Appendix.

VII. GROUPING OF CLAIMS

Appellant argues for the patentability of independent Claims 1 and 15 separately and apart from one another. Appellant argues for the patentability of dependent Claims 2-14 and 16-20 separately and apart from the independent claims from which Claims 2-14 and 16-20 depend.

VIII. ARGUMENT

The invention as defined in independent Claim 1 requires a method for matching medical condition information with a medical resource having a step of providing a computer network which has a plurality of remote computers and at least one remote server wherein the remote server hosts a website. Claim 1 also requires a step of accessing the website via an individual remote computer on the computer network. Further, Claim 1 requires a step of inputting a query into the website wherein the query relates to a medical condition. Still further, Claim 1 requires a step of providing a database on the remote server wherein the database stores information relating to a plurality

of medical conditions. Moreover, Claim 1 requires a step of searching the database for the information wherein the search is based on the query input into the database and the search discloses a medical resource that treats the medical condition queried. Claims 2-11, 13 and 14 set forth additional steps of Appellant's method for matching medical condition information with a medical resource.

Independent Claim 15 requires a system for matching medical condition information with a medical resource having a computer network which has a plurality of remote computers and at least one remote server wherein the remote server hosts a website. Additionally, Claim 15 requires a database connected to the remote server wherein the database stores information relating to a plurality of medical conditions. Further, Claim 15 requires a means for querying the database wherein the query relates to one of the medical conditions. Still further, Claim 15 requires a means for searching the database for the information. Moreover, the search is based on the query of the database and the information discloses a medical resource that treats the medical condition queried. Claims 16-20 set forth additional structural elements of Appellant's system for matching medical condition information with a medical resource

**A. THE CITED REFERENCES AND REJECTIONS
OF CLAIMS 1-11 and 13-20**

Claims 1-11 and 13-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Iliff* (U.S. Patent No. 6,022,315) in view of *Schlueter, Jr. et al.* (U.S. Patent No. 5,974,124).

In the Final Rejection, the Examiner stated:

Claims 1-11, 13-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Iliff*, U.S. Patent Number 6,002,315, in view of *Schlueter, Jr. et al.*, U.S. Patent Number 5,974,124, for the same reasons given in the previous Office Action (paper number 4). Further reasons appear hereinbelow.

Claims 1-2, 4-5, 8-11 and 13-20 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 4, section 6, pages 4-10), and incorporated herein.

The amendments to claims 3, 6 and 7 appear to have been made merely to correct minor typographical or grammatical errors rendering the claims indefinite. While these changes render the language of the claims as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 4, section 6, pages 4-10), and incorporated herein.

(See Final Rejection, page 3, section 5, sub-section A of Exhibit A of the Supplemental Appendix.)

**B. ILIFF OR SCHLUETER, JR. ET AL., TAKEN SINGLY OR
IN COMBINATION, DO NOT TEACH OR SUGGEST CLAIMS 1-11 AND 13-20,
AND IT WOULD NOT HAVE BEEN OBVIOUS TO COMBINE THEM BY ONE
HAVING
ORDINARY SKILL IN THE ART AT
THE TIME OF THE INVENTION**

With respect to the rejection of Claims 1-11 and 13-20 under

35 U.S.C. §103(a) as being unpatentable over *Iliff* in view of *Schlueter, Jr. et al.*, Appellant respectfully submits that the claims distinctly define the present invention from *Iliff* and *Schlueter, Jr. et al.*, taken singly or in combination, for the reasons that follow.

Iliff teaches a system for providing computerized medical diagnostic advice to the general public over a network, such as a telephone network. The network provides medical advice and access to health care information. The medical advice system determines if a serious medical condition exists and advises the patient to seek immediate medical attention if a serious medical condition exists. (See *Iliff*, column 36, lines 9-13.) The system performs a patient diagnosis, recommends the appropriate tests and provides a treatment table to obtain current treatment information for a particular disease or diagnosis. (See *Iliff*, column 75, lines 18-26.) Moreover, *Iliff* discloses that "if a diagnosis was reached by the script, process 2500 proceeds to state 2546 to provide the diagnosis or medical advice to the user." (See *Iliff*, Fig. 30, column 79, lines 7-9.) Furthermore, *Iliff* discloses "every person can have access to high quality, 100%-consistent and affordable medical advice and information." (See *Iliff*, column 64, lines 51-53.)

Schlueter, Jr. et al. teach a method and system that assists

medical practitioners who treat or prescribe treatment of patients having a medical condition which requires long-term profiling of medical data taken from the patient's body. Further, *Schlueter, Jr. et al.* teach that "the received, or raw, data consists of individual readings or measurements of medically-important variables of patients" wherein "one patient might be measuring heart rate and blood pressure, another body weight or body fat, and a third blood sugar." (See *Schlueter, Jr. et al.*, column 5, lines 53-58.) Moreover, *Schlueter, Jr. et al.* teach a system which "enables medical practitioners to quickly and easily spot trends and track the progress of patients they are treating without requiring excessive "extra steps" on the part of medical practitioners employing this invention." (See *Schlueter, Jr. et al.*, column 7, lines 4-8.)

On the contrary, Claim 1 requires a method for matching medical condition information with a medical resource having a step of inputting a query into the website wherein the query relates to a medical condition. Moreover, Claim 1 requires a step of searching the database for the information wherein the search is based on the query input into the database and the search discloses a medical resource that treats the medical condition queried.

The Examiner admitted that *Iliff* fails to explicitly

disclose inputting a query into the website wherein the query relates to a medical condition. The Examiner alleges *Schlueter, Jr. et al.* teaches inputting a query or request for data into the website wherein the query relates to a medical condition. On the contrary, *Schlueter, Jr. et al.* merely teach a "method and system which receives medical readings over long periods of time, stores the information as medical histories in a data base application, and presents the information to medical practitioners in a form which facilitates accurate diagnosis and treatment of patients' chronic medical condition." (See *Schlueter, Jr. et al.*, column 5, lines 47-52.) Nowhere does *Schlueter, Jr. et al.* teach or suggest a method having the step of inputting a query into the website wherein the query relates to a medical condition as alleged by the Examiner.

Clearly, neither *Iliff* nor *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a method for matching medical condition information with a medical resource having a step of inputting a query into the website wherein the query relates to a medical condition as required by Claim 1. Additionally, the Examiner admits that *Iliff* does not teach or suggest a method having the step of inputting a query into the website wherein the query relates to a medical condition as required by Claim 1. Moreover, nowhere does *Schlueter, Jr. et*

al. teach or suggest a method having a step of inputting a query into the website wherein the query relates to a medical condition as required by Claim 1. Rather, *Schlueter, Jr. et al.* merely teach a system which receives raw data consisting of individual readings or measurements of medically important variables of patients, stores the data, processes the data and presents the data to medical practitioners. Therefore, neither *Iliff* nor *Schlueter, Jr. et al.* teach a method for matching medical condition information with a medical resource having the step of inputting a query into the website wherein the query relates to a medical condition as required by Claim 1.

Neither *Iliff* nor *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a method for matching medical condition information with a medical resource having a step of searching the database for the information wherein the search is based on the query input into the database, and the search discloses a medical resource that treats the medical condition queried as required by Claim 1. *Iliff* merely teaches a system that "determines if a serious medical condition exists" and "if so, the system moves to state, plays a message that advises the patient to seek immediate medical attention and ends the evaluation process at a terminal state." (See *Iliff* column 36, lines 9-13.) Additionally, *Iliff* teaches that "the evaluation

process accesses a laboratory test of choice and imaging modality of choice database to recommends the appropriate tests for this patient at this point in time and a treatment table to obtain current treatment information for a particular disease or diagnosis." (See *Iliff* column 75, lines 21-26.) Nowhere does *Schlueter, Jr. et al.* teach or suggest a method having the step of searching the database for information wherein the search is based on the query input into the database, and the search discloses a medical resource that treats the medical condition queried.

Appellant submits that the steps required by Claim 1 of the present invention clearly differs from *Iliff* or *Schlueter, Jr. et al.*, taken singly or in combination. Specifically, the method defined by Claim 1 requires the steps of inputting a query into the website wherein the query relates to a medical condition and searching the database for the information wherein the search is based on the query input into the database and further wherein the search discloses a medical resource that treats the medical condition queried. Therefore, Appellant submits that the method of the claimed invention clearly requires defined steps in the claims that distinguishes the claimed invention from *Iliff* or *Schlueter, Jr. et al.*, taken singly or in combination. Moreover, the art fails to teach or

suggest the specific step defined in Claim 1; therefore, Claim 1 is patentably distinct from *Iliff* or *Schlueter, Jr. et al.*, taken singly or in combination.

Claim 15 requires a system for matching medical condition information with a medical resource having a means for querying the database wherein the query relates to one of the medical conditions. Moreover, Claim 15 requires a means for searching the database for the information wherein the information discloses a medical resource that treats the medical condition queried.

Neither *Iliff* nor *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a system for matching medical condition information with a medical resource having a means for querying the database wherein the query relates to one of the medical conditions as required by Claim 15. As discussed above, the Examiner admits that *Iliff* does not disclose inputting a query into the website wherein the query relates to a medical condition. Further, nowhere does *Schlueter, Jr. et al.* teach or suggest a system with a querying which relates to one of the medical conditions. Thus, neither *Iliff* nor *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a system for matching medical condition information with a medical resource having a means for querying the database wherein the

query relates to one of the medical conditions as required by Claim 15.

Neither *Iloff* nor *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a system for matching medical condition information with a medical resource having a means for searching the database for the information wherein the information discloses a medical resource that treats the medical condition queried as required by Claim 15. As discussed above, nowhere does *Iloff* or *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a system having a means for searching for the information based on a query wherein the information discloses a medical resource that treats the medical condition queried. Thus, neither *Iloff* nor *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a system for matching medical condition information with a medical resource having a means for searching the database for the information wherein the search is based on the query of the database and further wherein the information discloses a medical resource that treats the medical condition queried as required by Claim 15.

Appellant submits that the system of the claimed invention clearly requires defined elements in Claim 15 that distinguishes the claimed invention from *Iloff* or *Schlueter, Jr. et al.*, taken

singly or in combination. Moreover, the art fails to teach or suggest the specific elements defined in the Claim 15. Therefore, Claim 15 is patentably distinct from *Iliff* or *Schlueter, Jr. et al.*, taken singly or in combination.

Appellant further submits that one having ordinary skill in the art at the time of Appellant's invention would never have been motivated to modify *Iliff* with *Schlueter, Jr. et al.* in the manner suggested by the Examiner in formulating the rejections under 35 U.S.C. §103(a).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1545, 220 USPQ 193 (Fed. Cir. 1983).

Appellant submits that the Examiner has merely located components of Appellant's claimed invention. However, that the art disclosed components of Appellant's claimed invention, either separately or used in other combinations, is insufficient. A teaching, suggestion, or incentive must exist

to make the combination made by Appellant. *Interconnect Planning Corp. v. Feil*, 774 F. 2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Iloff* and *Schlueter, Jr. et al.* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art at the time of Appellant's invention would have been motivated to combine *Iloff* with *Schlueter, Jr. et al.* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a). Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103(a).

Even assuming that one having ordinary skill in the art could somehow have combined *Iloff* and *Schlueter, Jr. et al.* as set forth by the Examiner, the resultant combination still lacks the critical steps and elements positively recited in Claims 1 and 15, respectively.

In view of the foregoing, Appellant submits that the rejection of Claims 1 and 15 under 35 U.S.C. §103(a) is improper.

Dependent Claim 2 further requires the step of outputting the information to the individual remote computer. Nowhere do *Iloff* and *Schlueter, Jr. et al.*, taken singly or in combination,

teach or suggest a method having the steps of inputting a query into the website wherein the query relates to a medical condition and outputting the information to the individual remote computer as required by Claim 2. Therefore, Claim 2 would not have been obvious to one of ordinary skill in the art at the time of Appellant's invention in view of *Iliff* and *Schlueter, Jr. et al.* Accordingly, the rejection of Claim 2 under 35 U.S.C. §103(a) in view of *Iliff* and *Schlueter, Jr. et al.* is improper.

Dependent Claim 3 further requires that the medical conditions relate to diseases. Nowhere do *Iliff* and *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a method having the steps of inputting a query into the website wherein the query relates to a medical condition wherein the medical conditions relate to diseases as required by Claim 3. Therefore, Claim 3 would not have been obvious to one of ordinary skill in the art at the time of Appellant's invention in view of *Iliff* and *Schlueter, Jr. et al.* Accordingly, the rejection of Claim 3 under 35 U.S.C. §103(a) in view of *Iliff* and *Schlueter, Jr. et al.* is improper.

Dependent Claim 4 further requires the step of providing medical procedure information to one of the computers. Nowhere do *Iliff* and *Schlueter, Jr. et al.*, taken singly or in

combination, teach or suggest a method having the steps of inputting a query into the website wherein the query relates to a medical condition and providing medical procedure information to one of the computers as required by Claim 4. Therefore, Claim 4 would not have been obvious to one of ordinary skill in the art at the time of Appellant's invention in view of *Iliff* and *Schlueter, Jr. et al.* Accordingly, the rejection of Claim 4 under 35 U.S.C. §103(a) in view of *Iliff* and *Schlueter, Jr. et al.* is improper.

Dependent Claim 5 further requires the step of searching the database for medical procedure information. Nowhere do *Iliff* and *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a method having the steps of inputting a query into the website wherein the query relates to a medical condition and searching the database for medical procedure information as required by Claim 5. Therefore, Claim 5 would not have been obvious to one of ordinary skill in the art at the time of Appellant's invention in view of *Iliff* and *Schlueter, Jr. et al.* Accordingly, the rejection of Claim 5 under 35 U.S.C. §103(a) in view of *Iliff* and *Schlueter, Jr. et al.* is improper.

Dependent Claim 6 further requires the step of disclosing on one of the remote computers a practitioner that treats the medical condition queried. Nowhere do *Iliff* and *Schlueter, Jr.*

et al., taken singly or in combination, teach or suggest a method having the steps of inputting a query into the website wherein the query relates to a medical condition and disclosing on one of the remote computers a practitioner that treats the medical condition queried as required by Claim 6. Therefore, Claim 6 would not have been obvious to one of ordinary skill in the art at the time of Appellant's invention in view of *Iliff* and *Schlueter, Jr. et al.* Accordingly, the rejection of Claim 6 under 35 U.S.C. §103(a) in view of *Iliff* and *Schlueter, Jr. et al.* is improper.

Dependent Claim 7 further requires the step of disclosing to the individual remote computer the medical facility that treats the medical condition queried. Nowhere do *Iliff* and *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a method having the steps of inputting a query into the website wherein the query relates to a medical condition and disclosing to the individual remote computer the medical facility that treats the medical condition queried as required by Claim 7. Therefore, Claim 7 would not have been obvious to one of ordinary skill in the art at the time of Appellant's invention in view of *Iliff* and *Schlueter, Jr. et al.* Accordingly, the rejection of Claim 7 under 35 U.S.C. §103(a) in view of *Iliff* and *Schlueter, Jr. et al.* is improper.

Dependent Claim 8 further requires the step of disclosing specific medical resource information including a name of the medical resource, a location, contact information and services offered. Nowhere do *Iliff* and *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a method having the steps of inputting a query into the website wherein the query relates to a medical condition and disclosing specific medical resource information wherein the specific medical resource information includes a name of the medical resource, a location, contact information and services offered as required by Claim 8. Therefore, Claim 8 would not have been obvious to one of ordinary skill in the art at the time of Appellant's invention in view of *Iliff* and *Schlueter, Jr. et al.* Accordingly, the rejection of Claim 8 under 35 U.S.C. §103(a) in view of *Iliff* and *Schlueter, Jr. et al.* is improper.

Dependent Claim 9 further requires the step of linking one of the remote computers to a specific website relating to the medical resource. Nowhere do *Iliff* and *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a method having the steps of inputting a query into the website wherein the query relates to a medical condition and linking one of the remote computers to a specific website relating to the medical resource as required by Claim 9. Therefore, Claim 9 would not have been obvious to one of ordinary skill in the art at the

time of Appellant's invention in view of *Iliff* and *Schlueter, Jr. et al.* Accordingly, the rejection of Claim 9 under 35 U.S.C. §103(a) in view of *Iliff* and *Schlueter, Jr. et al.* is improper.

Dependent Claim 10 further requires a method wherein the information discloses a plurality of medical resources that treat the medical condition queried. Nowhere do *Iliff* and *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a method having the steps of inputting a query into the website wherein the information discloses a plurality of medical resources that treat the medical condition queried as required by Claim 10. Therefore, Claim 10 would not have been obvious to one of ordinary skill in the art at the time of Appellant's invention in view of *Iliff* and *Schlueter, Jr. et al.* Accordingly, the rejection of Claim 10 under 35 U.S.C. §103(a) in view of *Iliff* and *Schlueter, Jr. et al.* is improper.

Dependent Claim 11 further requires a method wherein the query includes identifying information of an individual using the website wherein search results disclosing medical resources match the identifying information to the medical resource. Nowhere do *Iliff* and *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a method having the steps of inputting a query into the website wherein the query includes identifying information of an individual using the website

wherein search results disclosing medical resources match the identifying information to the medical resource as required by Claim 11. Therefore, Claim 11 would not have been obvious to one of ordinary skill in the art at the time of Appellant's invention in view of *Iliff* and *Schlueter, Jr. et al.* Accordingly, the rejection of Claim 11 under 35 U.S.C. §103(a) in view of *Iliff* and *Schlueter, Jr. et al.* is improper.

Dependent Claim 13 further requires the steps of providing a plurality of websites on the computer network, accessing any one of the plurality of websites via the remote computer and searching the database via any one of the plurality of websites. Nowhere do *Iliff* and *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a method having the steps of inputting a query into the website wherein the query relates to a medical condition and providing a plurality of websites on the computer network as required by Claim 13. Further, neither *Iliff* nor *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a method having the steps of accessing any one of the plurality of websites via the remote computer and searching the database via any one of the plurality of websites as required by Claim 13. Therefore, Claim 13 would not have been obvious to one of ordinary skill in the art at the time of Appellant's invention in view of *Iliff* and *Schlueter, Jr. et al.* Accordingly, the rejection of Claim 13 under 35 U.S.C. §103(a)

in view of *Iliff* and *Schlueter, Jr. et al.* is improper.

Dependent Claim 14 further requires the steps of providing a plurality of databases on a plurality of remote servers wherein the databases store the information relating to the medical conditions, linking the databases via the computer network and searching the databases for the information. Nowhere do *Iliff* and *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a method having the steps of inputting a query into the website wherein the query relates to a medical condition and providing a plurality of databases on a plurality of remote servers wherein the databases store the information relating to the medical conditions as required by Claim 14. Further, neither *Iliff* nor *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a method having the steps of linking the database via the computer network and searching the databases for the information as required by Claim 14. Therefore, Claim 14 would not have been obvious to one of ordinary skill in the art at the time of Appellant's invention in view of *Iliff* and *Schlueter, Jr. et al.* Accordingly, the rejection of Claim 14 under 35 U.S.C. §103(a) in view of *Iliff* and *Schlueter, Jr. et al.* is improper.

Dependent Claim 16 further requires a means for outputting the information from an individual remote computer. Nowhere do *Iliff* and *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a system having a means for querying the

database wherein the query relates to one of the medical conditions and a means for outputting the information from an individual remote computer as required by Claim 16. Further, neither *Iliff* nor *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a system having a means for searching the database for the information wherein the search is based on the query of the database and further wherein the information discloses a medical resource that treats the medical condition queried as required by Claim 16. Therefore, Claim 16 would not have been obvious to one of ordinary skill in the art at the time of Appellant's invention in view of *Iliff* and *Schlueter, Jr. et al.* Accordingly, the rejection of Claim 16 under 35 U.S.C. §103(a) in view of *Iliff* and *Schlueter, Jr. et al.* is improper.

Dependent Claim 17 further requires the medical conditions to relate to diseases. Nowhere do *Iliff* and *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a system having a means for querying the database wherein the query relates to one of the medical conditions and the medical conditions relate to diseases as required by Claim 17. Further, neither *Iliff* nor *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a system having a means for searching the database for the information wherein the search is based on the query of the database and further wherein the information discloses a medical resource that treats the medical

condition queried as required by Claim 17.. Therefore, Claim 17 would not have been obvious to one of ordinary skill in the art at the time of Appellant's invention in view of *Iliff* and *Schlueter, Jr. et al.* Accordingly, the rejection of Claim 17 under 35 U.S.C. §103(a) in view of *Iliff* and *Schlueter, Jr. et al.* is improper.

Dependent Claim 18 further requires the information to relate to the medical conditions which further relate to medical procedures. Nowhere do *Iliff* and *Schlueter, Jr. et al.* taken singly or in combination, teach or suggest a system having a means for querying the database wherein the query relates to one of the medical conditions as required by Claim 18. Further, neither *Iliff* nor *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a system having a means for searching the database for the information wherein the search is based on the query of the database and further wherein the information discloses a medical resource that treats the medical condition queried as required by Claim 18. Moreover, neither *Iliff* nor *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a system with the information relating to the medical conditions which further relates to medical procedures as required by Claim 18. Therefore, Claim 18 would not have been obvious to one of ordinary skill in the art at the time of Appellant's invention in view of *Iliff* and *Schlueter, Jr. et al.* Accordingly, the rejection of Claim 18 under 35 U.S.C. §103(a)

in view of *Iliff* and *Schlueter, Jr. et al.* is improper.

Dependent Claim 19 further requires the information to relate to practitioners that treat the medical condition queried. Nowhere do *Iliff* and *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a system having a means for querying the database wherein the query relates to one of the medical conditions as required by Claim 19. Further, neither *Iliff* nor *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a system having a means for searching the database for the information wherein the search is based on the query of the database and further wherein the information discloses a medical resource that treats the medical condition queried as required by Claim 19. Moreover, neither *Iliff* nor *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a system having the information relating to practitioners that treat the medical condition queried as required by Claim 19. Therefore, Claim 19 would not have been obvious to one of ordinary skill in the art at the time of Appellant's invention in view of *Iliff* and *Schlueter, Jr. et al.* Accordingly, the rejection of Claim 19 under 35 U.S.C. §103(a) in view of *Iliff* and *Schlueter, Jr. et al.* is improper.

Dependent Claim 20 further requires a link on the website wherein the link links one of the remote computers to another website providing further information relating to the medical resource. Nowhere do *Iliff* and *Schlueter, Jr. et al.*, taken

singly or in combination, teach or suggest a system having a means for querying the database wherein the query relates to one of the medical conditions as required by Claim 20. Further, neither *Iliff* nor *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a system having a means for searching the database for the information wherein the search is based on the query of the database and further wherein the information discloses a medical resource that treats the medical condition queried as required by Claim 20. Moreover, neither *Iliff* nor *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a system having a link on the website wherein the link links one of the remote computers to another website providing further information relating to the medical resource as required by Claim 20. Therefore, Claim 20 would not have been obvious to one of ordinary skill in the art at the time of Appellant's invention in view of *Iliff* and *Schlueter, Jr. et al.* Accordingly, the rejection of Claim 20 under 35 U.S.C. §103(a) in view of *Iliff* and *Schlueter, Jr. et al.* is improper.

In view of the forgoing, the rejection of Claims 1-11 and 13-20 under 35 U.S.C. §103(a) is improper.

**C. THE CITED REFERENCES AND REJECTION
OF CLAIM 12**

Claim 12 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Iliff* (U.S. Patent No. 6,022,315) in view of *Schlueter, Jr. et al.* (U.S. Patent No. 5,974,124) and further in

view of *Siegrist, Jr. et al* (U.S. Patent No. 5,652,842).

In the Final Rejection, the Examiner stated:

Claim 12 has not been amended and is rejected for the same reasons given in the previous Office Action (paper number 4, section 7, pages 10-11), and incorporated herein.

(See Final Rejection, page 4, section 6, sub-section A of Exhibit A of the Supplemental Appendix.)

Contrary to the assertions of the Examiner, dependent Claim 12 further defines a method for matching medical condition information with a medical resource having the step of disclosing a plurality of medical resources that treat the disorder queried. Additionally, Claim 12 requires the step of ranking the medical resources based on how the medical resources match the query.

D. ILIFF, SCHLUETER, JR. ET AL., OR SIEGRIST, JR. ET AL., TAKEN SINGLY OR IN COMBINATION, DO NOT TEACH OR SUGGEST CLAIM 12, AND IT WOULD NOT HAVE BEEN OBVIOUS TO COMBINE THEM BY ONE OF ORDINARY SKILL IN THE ART AT THE TIME OF THE INVENTION

Claim 12 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Iliff* in view of *Schlueter, Jr. et al.* and further in view of *Siegrist, Jr. et al.* Appellant respectfully submits that Claim 12 distinctly defines the present invention from *Iliff, Schlueter, Jr. et al.* or *Siegrist, Jr. et al.*, taken singly or in combination, for the reasons that follow. Further, this rejection is respectfully traversed in view of the

arguments set forth above with respect to Claim 1 and for the reasons set forth below.

Siegrist, Jr. et al. fail to teach or suggest a method for matching medical condition information with a medical resource having a step of inputting a query into the website wherein the query relates to a medical condition as required by Claim 1. Moreover, *Siegrist, Jr. et al.* fail to teach or suggest a method having the steps of disclosing a plurality of medical resources that treat the disorder queried and ranking the medical resources based on how the medical resources match the query as required by Claim 12.

Moreover, none of *Ilyff, Schlueter, Jr. et al.*, or *Siegrist, Jr. et al.*, taken singly or in combination, teach the elements of independent Claim 1, from which Claim 12 depend. More specifically, none of the references teach a method having the steps of inputting a query into the website wherein the query relates to a medical condition and searching the database for the information wherein the search is based on the query input into the database and further wherein the search discloses a medical resource that treats the medical condition queried as required by Claim 1.

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F. 2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1545, 220 USPQ 193 (Fed. Cir. 1983).

Appellant submits that the Examiner has merely located components of Appellant's claimed invention. However, that the art disclosed components of Appellant's claimed invention, either separately or used in other combinations, is insufficient. A teaching, suggestion, or incentive must exist to make the combination made by Appellant. *Interconnect Planning Corp. v. Feil*, 774 F. 2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988). No such teaching, suggestion or incentive exists in *Iloff, Schlueter, Jr. et al.* or *Siegrist, Jr. et al.* to provide the features set forth in Appellant's invention. Therefore, one of ordinary skill in the art would not have been motivated at the time of Appellant's invention to combine *Iloff, Schlueter, Jr. et al.* and *Siegrist, Jr. et al.*

Still further, Appellant submits that the Examiner is merely "piece-mealing" references together providing various teachings and positively defined steps of Appellant's method to deprecate

the claimed invention. Of course, hindsight reconstruction of Appellant's invention is impermissible. Since no suggestion exists to combine *Ilyff, Schlueter, Jr. et al.* and *Siegrist, Jr. et al.*, the Examiner cannot arbitrarily do so to reject the claims. Instead, a reason is required why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975).

The court in *In re McLaughlin* stated "[T]here is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art." *In re McLaughlin*, 170 USPQ 209 (CCPA 1971).

In considering obviousness, the critical inquiry is whether something in the art as a whole suggests the desirability, and thus the obviousness, of making a combination. *In re Newell*, 891 F.2d 899, 901-02, 13 USPQ 2d 1248, 1250 (Fed. Cir. 1987).

Since the Examiner has failed to establish a *prima facie* case of obviousness in combining *Ilyff* and *Schlueter, Jr. et al.* with *Siegrist, Jr. et al.*, the rejection of Claim 12 under 35 U.S.C. §103(a) is improper.

CONCLUSION

For the foregoing reasons, Appellant respectfully submits that the rejections of Claims 1-20 are erroneous as a matter of

law and fact and respectfully requests the Board to reverse the rejections.

Respectfully submitted,



(Reg. No. 35,018)

Brian M. Mattson
Patents+TMS
A Professional Corporation
1914 North Milwaukee Ave.
Chicago, IL 60647
(773) 772-6009
ATTORNEY FOR APPELLANT

IX. TABLE OF CONTENTS

- 1) APPENDIX: Claims 1-20
- 2) SUPPLEMENTAL APPENDIX

EXHIBIT A: Final Rejection

EXHIBIT B: *Iliff* (U.S. Patent No. 6,022,315)

EXHIBIT C: *Schlueter, Jr. et al.* (U.S. Patent No. 5,974,124)

EXHIBIT D: *Siegrist, Jr. et al.* (U.S. Patent No. 5,652,842)

APPENDIX: Claims 1-20

1. A method for matching medical condition information with a medical resource, the method comprising the steps of:

providing a computer network having a plurality of remote computers and at least one remote server wherein the remote server hosts a website;

accessing the website via an individual remote computer on the computer network;

inputting a query into the website wherein the query relates to a medical condition;

providing a database on the remote server wherein the database stores information relating to a plurality of medical conditions; and

searching the database for the information wherein the search is based on the query input into the database and further wherein the search discloses a medical resource that treats the medical condition queried.

2. The method of Claim 1 further comprising the step of:

outputting the information to the individual remote computer.

3. The method of Claim 1 wherein the medical conditions relate to diseases.

4. The method of Claim 1 further comprising the step of:

providing medical procedure information to one of the computers.

5. The method of Claim 1 further comprising the step of:
searching the database for medical procedure information.
6. The method of Claim 1 further comprising the step of:
disclosing on one of the remote computers a practitioner that treats the medical condition queried.
7. The method of Claim 1 further comprising the step of:
disclosing to the individual remote computer the medical facility that treats the medical condition queried.
8. The method of Claim 1 further comprising the step of:
disclosing specific medical resource information wherein the specific medical resource information includes a name of the medical resource, a location, contact information and services offered.
9. The method of Claim 1 further comprising the step of:
linking one of the remote computers to a specific website relating to the medical resource.
10. The method of Claim 1 wherein the information discloses a plurality of medical resources that treat the medical condition queried.
11. The method of Claim 1 wherein the query includes identifying information of an individual using the website wherein search results disclosing medical resources match the identifying

information to the medical resource.

12. The method of Claim 1 further comprising the step of:

disclosing a plurality of medical resources that treat the disorder queried; and

ranking the medical resources based on how the medical resources match the query.

13. The method of Claim 1 further comprising the step of:

providing a plurality of websites on the computer network;
accessing any one of the plurality of websites via the remote computer; and

searching the database via any one of the plurality of websites.

14. The method of Claim 1 further comprising the step of:

providing a plurality of databases on a plurality of remote servers wherein the databases store the information relating to the medical conditions;

linking the databases via the computer network; and

searching the databases for the information.

15. A system for matching medical condition information with a medical resource, the system comprising:

a computer network having a plurality of remote computers and at least one remote server wherein the remote server hosts a website;

a database connected to the remote server wherein the

database stores information relating to a plurality of medical conditions;

means for querying the database wherein the query relates to one of the medical conditions; and

means for searching the database for the information wherein the search is based on the query of the database and further wherein the information discloses a medical resource that treats the medical condition queried.

16. The system of Claim 15 further comprising:

means for outputting the information from an individual remote computer.

17. The system of Claim 15 wherein the medical conditions relate to diseases.

18. The system of Claim 15 wherein the information relating to the medical conditions further relates to medical procedures.

19. The system of Claim 15 wherein the information relates to practitioners that treat the medical condition queried.

20. The system of Claim 15 further comprising:

a link on the website wherein the link links one of the remote computers to another website providing further information relating to the medical resource.

SUPPLEMENTAL APPENDIX